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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,823	10/23/2003	David Grewe	CRD1061CIP1	6328
27777	7590	01/10/2006		EXAMINER
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			HOEKSTRA, JEFFREY GERBEN	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

S8

Office Action Summary	Application No.	Applicant(s)
	10/691,823	GREWE ET AL.
	Examiner	Art Unit
	Jeffrey G. Hoekstra	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 October 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) 4.22 and 26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Priority

1. It is noted that this application is filed as a Continuation In Part to claimed subject matter disclosed in prior Application No. 10/224,168, filed 08/20/2002 and relies on the filing date of the prior application under 35 U.S.C. 119(e).

Information Disclosure Statement

2. The information disclosure statement(s) (IDS) submitted on 01/26/2004 is/are acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the examiner is considering the information disclosure statement(s).

Claim Objections

3. Claims 4, 22, and 26 are objected to because of the following informalities: "the elongated member" is referenced and further defined. There are several aforementioned "elongated member(s)" and further clarification/definition is required. Appropriate correction is required.

4. For examination, the examiner interprets "the elongated member" to be the slidably disposed elongated deflection member with flattened distal region.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Regarding claim 18, the phrase "equal to about" renders the claim indefinite because the tolerances of the dimensions are unclear. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Gambale et al (5060660). For claims 1, 19, and 23, Gambale et al discloses a steerable guidewire comprising an elongate flexible tubing 32, a flexible helical coil 42 providing torsional rigidity and having multiple turns, a rectangular cross section, continuous interlocking undulations, and is attached to the distal region of the tubing member (column 5 line 65 – column 6 line 30), a elongated deflection member 46 having a cylindrical cross section and slidably disposed within said tubing and said coil having a flattened distal profile (column 6 lines 35-52), a retaining ribbon 62 attached to the distal end of the tubing member and oriented generally parallel to the flattened deflection member, and a rounded attachment member 44 engaging the distal ends of the coil, deflection member, and retaining ribbon such that a push/pull of said deflection member causes bi-directional deflection.

9. For claims 2, 3, 20, 21, 24, and 25, Gambale et al discloses disposing the windings of the helical coil in such a manner as to create a square or sin wave profile (column 6 lines 26-30).

10. For claims 4, 22, and 26, Gambale et al discloses an elongated deflection member 46 with a square cross section (column 6 lines 35-52).

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11. For claims 5 and 27, Gambale et al discloses said retaining and deflection ribbons in a normally biased and arcuate configuration causing the distal end of said coil to be curved in a resting position (column 3 line 67 – column 4 line 2).
12. For claims 6 and 28, Gambale et al discloses a deflection member with a circular cross section in the proximal region that extends to the distal portion of the tubing (column 7 lines 38-32).
13. For claim 7, Gambale et al discloses said retaining ribbon 62 extending from the distal region of the flexible tubing to approximately distal end of the flexible helical coil.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 8, 10-13, and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al in view of Schaer et al (5882333). For claim 8, Gambale et al discloses the claimed steerable guidewire except for the attachment member being a rounded bead. Schaer et al teaches an attachment member 35 in the form of a rounded bead. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire as taught by Gambale et al, with Schaer et al for the purpose of embedding the coil, deflection ribbon, and retaining ribbon in a manner beneficial to navigating tortuous vasculature.

17. For claims 10-13 and 29-32, Gambale et al discloses the claimed steerable guidewire, including the attachment member contacting the helical coil to form a circular surface within which the deflection and retaining ribbons engage said surface at a location offset (and opposite each other) of the center and joining the ribbons as best seen in Figure 4b, except for the attachment member being a rounded bead. Schaer et al teaches an attachment member 35 in the form of a rounded bead. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire as taught by Gambale et al, with Schaer et al for the purpose of embedding the coil, deflection ribbon, and retaining ribbon in a manner beneficial to navigating tortuous vasculature.

18. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al in view of Schaer et al and in further view of Hayzelden et al (2002/0165534). For claim 9, Gambale et al and Schaer et al disclose the claimed steerable guidewire except for forming the rounded bead with epoxy. Hayzelden et al teaches an attachment

member 50 composed of epoxy. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire as taught by Gambale et al and Schaer et al, with Hayzelden et al for the purpose of embedding the coil, deflection ribbon, and retaining ribbon in an material with appropriate biocompatibility.

19. Claims 14-15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al in view of Schaer et al and in further view of Hayzelden et al. Gambale et al and Schaer et al disclose the claimed steerable guidewire except for the deflection and retaining ribbons forming a single unitary element having a generally U-shaped configuration providing a predetermined spacing between the ribbons oriented parallel to each other. Hayzelden et al teaches a unitary U-shaped deflection/retaining member 48 with a predetermined spacing between the two opposing regions oriented parallel to each other. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire as taught by Gambale et al and Schaer et al, with Hayzelden et al for the purpose of embedding the maintaining the configuration of the deflection/retaining ribbon in a manner beneficial to navigating tortuous vasculature and retaining a desirable shape configuration prior to insertion.

20. Claims 16-18 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al in view of Schaer et al and Hayzelden et al and in further view of Palermo (4886067). Gambale et al, Schaer et al, and Hayzelden et al disclose the claimed steerable guidewire, including the thickness of the flattened deflection/retaining member's distal portion being 0.001 – 0.003 inches (Gambale et al,

column 6 lines 64-69), except for intermittent flattened versus rounded portions of the deflection/retaining ribbon(s) and the distal tapering of the thickness. Palermo teaches a guidewire with a circular cross section wire/ribbon progressively flattened in the distal direction (column 1 lines 62-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire as taught by Gambale et al, Schaer et al, and Hayzelden et al, with Palermo for the purpose of configuring the distal region of the deflection/retaining ribbon in a manner beneficial to attaining torsional rigidity and increased flexibility whilst navigating tortuous vasculature while simultaneously retaining a desirable shape prior to insertion.

21. Claims 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gambale et al in view of Palermo. Gambale et al discloses the claimed steerable guidewire system except for the flexible tubing and deflection member coupled to a control handle comprising a release mechanism is provided for guidewire detachment, a movable knob for longitudinal deflection of the deflection member in the distal direction, and wherein the deflection member extends the entire length of the handle. Palermo teaches a control handle 53 coupled to flexible tubing 20 and deflection member 44 with a movable knob 66 to impart distal curvature wherein the deflection member extends the entire length of the handle and beyond as best seen in Figure 4 and wherein when the retention member 70 is removed the guidewire is removably detached from said handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the guidewire system as taught by Gambale et al, with Palermo et al for the purpose of configuring the steerable guidewire system with

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mechanisms to attach/remove the guidewire with/from a handle including a knob to control the distal curvature of the guidewire for navigating tortuous vasculature.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey G. Hoekstra whose telephone number is (571)272-7232. The examiner can normally be reached on Monday through Friday, 8:00 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F. Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGH

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